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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/468,611	12/21/1999	ERIC B. REMER	42390.P7278	3835

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EXAMINER

HAYES, JOHN W

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 11/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/468,611	REMER ET AL. <i>h</i>
	Examiner John W Hayes	Art Unit 3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 30 September 2002.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-10,13 and 25-32 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-10,13 and 25-32 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 21 December 1999 is/are: a) accepted or b) objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

    1. Certified copies of the priority documents have been received.

    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

***Status of Claims***

1. Applicant has canceled claims 11-12 and 14-24, amended claims 1-2, 4, 8 and 13 and added new claims 25-32 in the amendment filed 30 September 2002. Thus, claims 1-10, 13 and 25-32 remain pending and are presented for examination.

***Response to Arguments***

2. Applicant's arguments filed 30 September 2002 have been fully considered but they are not persuasive. Applicant argues that Misra fails to disclose wherein the expiration date for a license is stored on the computer to which the associated license is stored. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., storing the expiration date of a license on the computer to which the license is stored) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims merely recite that a first license is generated on a first computer and a second license is generated on a second computer, each being valid for a predetermined period of time. Examiner submits that there are no limitations currently recited in the claims that specify the location of where the licenses are stored, or specifically where the "predetermined periods of time" are stored. Furthermore, examiner respectfully disagrees with applicant's characterization of the reference to Misra. Examiner submits that Misra discloses a license server that stores a number of licenses available and an expiration date associated with each license (Col. 7, lines 12-65 and Table 1) as well as a client computer that stores a software license in a license cache and wherein the software license contents includes the expiration date (Col. 4, lines 63-67; Table 5; Col. 12, lines 7-15; Col. 15, lines 47-50).

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Applicant further asserts that Misra does not disclose selectively refreshing a license. Examiner respectfully disagrees and notes that Misra discloses refreshing a software license on a client when the client license becomes expired (Col. 16, lines 37-67).

Examiner notes that the rejections have been updated based upon applicant's amendments and are included below for applicant's convenience.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-6, 8-10, 13 and 25-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Misra et al, U.S. Patent No. 6,189,146 B1.

As per Claims 1 and 13, Misra et al discloses a method for licensing software comprising:

- generating on a first computer a first license for software installed on the first computer, the first license valid for a first predetermined period of time (Col. 2, lines 62-67; Col. 3, lines 22-25; Table 1; Col. 11, lines 45-51; Col. 12, lines 8-14)

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- generating on a second computer a second license for the installed software, the second license valid for a second predetermined period of time (Col. 2, lines 48-55; Col. 8, lines 35-67; Table 3; Col. 9, lines 29-36; Col. 13, lines 61-63)

- obtaining from the second computer the second license (Col. 4, lines 54-59; Col. 12, lines 20-27; Col. 14, lines 8-14 and 49-53)

- replacing the first license with the second license (Col. 16, lines 49-67)

- selectively refreshing the second license prior to expiration of the second predetermined period of time (Col. 14, lines 14-51; Col. 16, lines 49-67).

As per **Claims 2 and 25**, Misra et al further disclose wherein the first and second licenses each share a unique identifier to associate the first and second licenses with the first computer (Col. 9, lines 29-61; Col. 10, lines 51-59; Col. 12, lines 47-67)

As per **Claims 3, 10, 26 and 32**, Misra et al further disclose wherein the first and second licenses are digitally signed (Col. 13, lines 42-63; Col. 14, lines 25-38).

As per **Claims 4 and 27**, Misra et al further disclose wherein obtaining further comprises:

- connecting to the second computer (Col. 14, lines 14-16)

- providing the second computer with at least some of the data from the first license (Col. 14, lines 24-30)

- exchanging the provided data from the first license for the second license (Col. 14, lines 49-53; Col. 15, lines 11-18 and 37-49).

As per **Claims 5-6 and 28-29**, Misra et al further disclose wherein connecting to the second computer is performed using a communications network (Col. 4, lines 43-49).

As per **Claims 8 and 30**, Misra et al further discloses wherein replacing further comprises:

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- matching the unique identifier of the second license to the unique identifier of the first license, and if not matched discarding the second license without replacing the first license (Col. 11, lines 45-65; Col. 11 line 66-Col. 12 line 7; Col. 14, lines 30-39), and

- authenticating the digital signature of the second license, and if not authentic discarding the second license without replacing the first license (Col. 12, lines 8-15).

As per **Claims 9 and 31**, Misra et al disclose verifying whether the replaced license is valid, including determining whether the replaced license has expired (Col. 14, lines 30-48).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et al, U.S. Patent No. 6,189,146 B1.

As per **Claim 7**, Misra et al disclose all the limitations of claim 5, however, fail to specifically disclose wherein exchanging includes formatting the data from the first license using XML and exchanging the formatted data using the HTTP protocol. Examiner takes Official Notice that formatting data using XML format and exchanging data using the HTTP protocol was well known in the art at the time of applicants invention. Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use the XML format for formatting data and use the HTTP protocol for exchanging data since these formats and protocols were commonly used, especially in Internet communications since they were readily available and convenient to use.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. The prior art previously made of record and not relied upon is considered pertinent to applicant's disclosure.

- Ross et al disclose a method and apparatus for electronic licensing in a network environment to facilitate product licensing and upgrades
- Coley et al disclose an automated system for management of licensed software and enabling or disabling the software accordingly
- Griswold discloses a license management system that periodically invokes a license check monitor to ensure valid usage of software and terminates use of the software is appropriate
- Horstmann discloses a method of relicensing of electronically purchased software
- Knutson discloses a method for licensing computer programs using DSA signature
- Carter et al disclose a method for network license authentication
- Cohen discloses a method for software licensing electronically distributed programs

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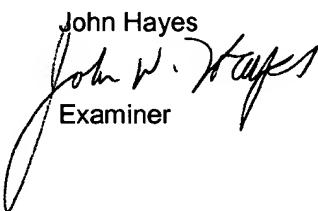
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

The Fax phone number for the **UNOFFICIAL FAX** for the organization where this application or proceeding is assigned is (703) 746-5531 (for informal or draft communications, please label "PROPOSED" or "DRAFT").

The Fax phone number for the **OFFICIAL FAX** for the organization where this application or proceeding is assigned is (703) 305-7687 (for formal communications intended for entry including After-Final communications).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

John Hayes  
  
Examiner

04 November 2002